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REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 4, 7, 10-12, 21-22, 29 and 30 are pending in the application. Reconsideration of the claims is respectfully requested.

In paragraph 8 on page 6 of the Official Action, Claims 4, 7, 10, 12, 20-22 and 29-30 were rejected under 35 USC § 103(a) as being unpatentable over Capps (US Publication 2002/0111813) in view of Lloyd-Jones (US Publication 2002/0055955), and further in view of Goldberg (US Publication 2004/0008872). In paragraph 12 on page 7 of the Official Action, Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Capps, Lloyd-Jones and Goldberg, in view of Davis et al. (US Publication 2002/0001395). Applicants respectfully traverse the rejections.

Capps fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. As admitted by the Office Action, Capps does not disclose an image content identifier.

In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term." *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317.

Rather, Capps' program module parses an electron document to identify a person, retrieves data relevant to the person, and compares the retrieved data to at least one electronic database using conventional techniques. *See* [0053]. Applicants respectfully submit that the electronic database is not an image content identifier as recited and defined by Applicants. More specifically, Capps identifies "characteristics of a person or persons" (i.e., any data that represents at least one person. *See* Abstract) and then compares these characteristics to information

contained in a database. *See* [0052] and [0053]. In sharp contrast, Applicants' claims require analyzing a digital image media file for determining if a portion of said at least one digital image file matches an image content identifier.

Furthermore, Capps fails to disclose an image content identifier having an associated electronic address of a second party. Moreover, if Capps fails to disclose an image content identifier, Capps' cannot be said to disclose an image content identifier having an associated electronic address of a second party.

Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. Goldberg was cited to disclose facial identifier functionality. Goldberg does not disclose image content identifier having an associated electronic address of a second party.

Lloyd-Jones fails to remedy the deficiencies of Capps and Goldberg as Lloyd-Jones fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants' independent claims. Rather, Lloyd-Jones discloses that a user can annotate an image by associating metadata with icons and then dragging and dropping the icon on an image. *See* Fig. 1, step 109 and [0029, 0030]. The metadata associated with the selected icon describes a person's name and email address, and is stored in a list associated with the image file in a database along with the position where the icon was dropped within the image. *See* Fig. 1, step 113 and [0039]. If a user wished to e-mail images to another person, an e-mail application must search another list associated with another image. *See* [0039]. Accordingly, there is nothing in Lloyd-Jones that discloses an image content identifier having an associated electronic address of a second party.

It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis

still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated electronic address of a second party as previously discussed.

Therefore, in view of the above remarks, Applicants' independent claims and their dependents are patentable over the cited references.

As an additional argument, Applicants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
(M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For example, it is respectfully submitted that Goldberg fails to provide any suggestion to implement or otherwise be combined with an apparatus for annotating an image as described in Lloyd-Jones. Moreover, Lloyd-Jones fails to provide any suggestion to implement or otherwise be combined with a system for recognizing a patron's face as described in Goldberg.

Thus, Appellant respectfully contends that a *prima facie* case of obviousness has not been established as no "clear and particular" evidence of motivation to combine can be identified.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.